

REMARKS

The present response is to the Office Action mailed in the above-referenced case on June 5, 2003. Claims 1-18 are presented for examination. The Examiner has objected to the disclosure and claims 13-18 due to informalities. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting. Applicant herein provides new pages to correct the objection to the specification and a terminal disclaimer to overcome the double patenting rejection.

Claims 1, 2, 5-6, 9-10, 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Pepe et al. (U.S. 5,742,905), hereinafter Pepe. Claims 4, 8, 12 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe, and claims 3, 7, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe and further in view of Fuller et al. (6,545,589), hereinafter Fuller.

Regarding the Examiner's merit rejections of applicant's claims, applicant has carefully studied the prior art cited and applied by the Examiner, and the Examiner's rejections and statements of the instant Office Action. In response applicant herein amends claim 13, and presents argument to more particularly point out and clarify the subject matter of applicant's invention regarded as advantageously distinct over the prior art, and therefore patentable over the references presented by the Examiner. Applicant points out argues the limitations of applicant's claims which embody the patentable subject matter, which the Examiner appears to have misunderstood in his rejections and statements.

Regarding claim 1, the Examiner has stated that Pepe teaches applicant's system for receiving and forwarding e-mail messages, including all of the limitations of applicant's claim including comparing characteristics of a

subscriber's received e-mail messages with stored subscriber specified characteristics, and alerting the subscriber when a characteristic match is found. Applicant respectfully disagrees with the Examiner's interpretation of the teachings of Pepe, and argues that a prima facie rejection is clearly not supported by the teachings.

Applicant's invention specifically teaches and claims alerting the subscriber that a characteristic match has been found between a received message and those provided by, and pre-stored by the subscriber. Pepe, in contrast, teaches sending alert notifications from servers to servers and from servers to subscribers, that a message has been received.

Applicant now wishes to direct the Examiner's attention to applicant's specification beginning on page 4, line 22, in reference to applicant's Figs. 1a-1b. It is clearly described that a copy of a received message is retained on the server and the content of the message is then analyzed in order to determine whether a match between any characteristics of the message content exists with pre-programmed stored characteristics provided by the subscriber. When a match is found an alert is sent to the subscriber, the alert identified with an ID stamp, whereby the subscriber can request either a fax back or a forwarding of the specific message by phone using the id stamp, utilizing various known means.

In contrast, Pepe, in every aspect of his invention, only teaches sending a notification to the server or to the subscriber that a message has been received, not that a characteristic match has been found between contents of the message in those provided by, and stored for the subscriber, as is taught and claimed in applicant's invention. For example, Pepe teaches that the received message can be an e-mail message (col. 4, line 56-col. 5, line 9) and further teaches stored subscriber profiles (col. 7, lines 3-15), but Pepe teaches specifically (col. 34, lines 60-65) that the subject of the message or address of the message may be screened,

but makes no mention of screening the actual content of the message, as applicant's invention teaches. The portion of the reference specifically recites "The subscriber can select ...where notification of e-mail receipt should be delivered..."

Pepe further teaches (col. 6, lines 11-19) that the subscriber may have notification of a voicemail or fax message receipt directed to a wireless PDA in the form of e-mail messages, and the notification that the message was received may be rerouted to other subscriber devices and means. Pepe teaches, in another aspect, (col. 10, lines 55-65) upon arrival of an e-mail message a notification is sent to the PCI application server of the arrival of e-mail, and the PCI server queries the profile cache or PCI database and determines where to forward to e-mail driven by the subscriber's stored profile, and what media, if any, to use in sending the notification of e-mail arrival. Cross media notification of message receipt is further taught, in yet another aspect of the invention of Pepe (col. 20, lines 42-46), wherein the "alert" sent to the subscriber is a notification e-mail having the subject of "message notification".

Further to the above, Pepe does not teach analyzing a copy of the received message to determine if a characteristic match exists, as taught in applicant's invention. Pepe does teach (col. 26 line 65-col. 27, line 7), for subject e-mail screening, analyzing the subject field of the e-mail before comparing the address field, and matching the subject field to an entry on a stored screening list to determine forwarding, but there is clearly no teaching of analyzing the content of the message to determine a characteristic match, and upon finding such a match, alerting the subscriber that a match has been found, as in applicant's invention. The body of the message may contain a great many additional characteristics in which to utilize for matching with stored characteristics supplied by the subscriber, thereby enhancing message screening and filtering capability and

flexibility. The aspect of characteristic matching and alerting the subscriber of matches found, is a patentable distinction which is key to applicant's invention, and which is simply not taught or suggested anywhere in Pepe. Pepe simply teaches notifying that when message is received, notifying the subscriber that a message has been received, and does not teach that a message having certain characteristics matching stored characteristics has been received, or even that a message of any certain type at all has been received, for that matter.

In view of applicant's above arguments presented on behalf of claim 1, applicant believes that the claim is clearly and unarguably patentable in its present form over Pepe, as the invention clearly fails to teach characteristic matching and alerting the subscriber to matches found, as is taught and claimed by applicant.

Claims 5, 9, and 13 are applicant's independent claims reciting the e-mail server, method for receiving, filtering and routing e-mail messages, and agent for processing e-mail messages, in accordance with the e-mail receiving and forwarding system recited in applicant's independent claim 1. The Examiner has rejected claims 5, 9, and 13 for the reasons applied to claim 1. Claims 5 and 9 recite the specific limitations as argued above by applicant on behalf of claim 1, comparing characteristics of messages to specific stored characteristics provided by the subscriber, and alerting the subscriber when a characteristic match is found. Applicant's claim 13 specifically recites a comparator adapted for comparing characteristics of received messages with stored characteristics, and tagging those messages wherein the characteristics match. Applicant herein amends the language of claim 13 to also include an alert mechanism for alerting a subscriber to the receipt of messages having characteristics matching the stored characteristics, as recited in claim 14. Claim 14 is herein accordingly cancelled.

The Examiner has rejected claims 4, 8, 12 and 18 as being unpatentable over Pepe, and claims 3, 7, 12 and 17 as being unpatentable over Pepe and further

in view of Fuller. As argued above by applicant, Pepe does not disclose or suggest comparing message characteristics of incoming messages to characteristics provided by, and stored on behalf of the subscriber, nor does Pepe teach alerting the subscriber that a characteristic match has been found. Pepe simply teaches sending notification that a message has been received, and therefore clearly fails as a primary reference for reading on applicant's independent claims, and for combining with Fuller to read on applicant's depending claims.

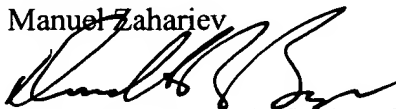
Applicant strongly believes that, as argued and amended above, independent claims 1, 5, 9 and 13 are clearly and unarguably patentable over the prior art cited and applied by the Examiner. Claims 2-4, 6-8, 10-12, and 15-18 are then patentable on their own merits, or at least as depended from a patentable claim.

It is therefore respectfully requested that this application be reconsidered, the claims be allowed, and that this case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this amendment, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,

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